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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,940	11/06/2000	Richard M. Fike	0942.4290006/RWE/BJD	7464

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EXAMINER

LAMBERTSON, DAVID A

ART UNIT

PAPER NUMBER

1636

14

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/705,940

Applicant(s)

FIKE, RICHARD M.

Examiner

David A. Lambertson

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 12 May 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 40-43.

Claim(s) rejected: 1-10, 15, 16, 18-29, 31-34 and 36-39.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: See Continuation Sheet

DAVID GUZO  
PRIMARY EXAMINER  
*David Guzo*

Continuation of 2. NOTE: Applicant has amended the claims to overcome an objection directed to the recitation of improper multiple-dependent claims. In the Final Office Action, it was clearly stated that claims 40-43 were not examined on the merits. Entry of the amendment would require that these claims now be examined on the merits, which would require a new search and new consideration. Furthermore, newly added claim 44 has not been searched on the merits, and a search of said claim would require a new search and new consideration. Contrary to applicant's assertion in the after final response, there is no indication in the previous Office Action that these claims would be entered or examined After Final.

Continuation of 5. does NOT place the application in condition for allowance because: applicant's arguments regarding the rejection under 35 USC 102(b) are not convincing. Applicant asserts that, when using two buffer salts in an automatically pH-adjusting medium powder, that it would not be inherent to use two buffer salts of opposing forms, or determine the ratio of those opposing forms in order to achieve the desired pH. This argument is not convincing because it was well-known at the time of the invention to use buffer salts of opposing forms to automatically obtain a desired pH without the need to subsequently add a pH adjusting agent. This is supported by the fact that there were published charts wherein the ratios of such opposing salts were previously determined for the explicit purpose of obtaining a desired pH without the need of a subsequent pH adjusting agent (see for example Gomori, Methods in Enzymology 16: 138-146, 1955). When practicing the invention taught by WO 98/36051, one would inherently consult these charts in order to use the one or more buffer salts used in the generation of an automatically pH-adjusting medium. Therefore, the applied WO98/36051 does inherently teach the use of and determination of ratios of opposing pH forms of buffer salts when practicing the invention taught therein.

Additionally, applicant is directed to MPEP 2131.01 as it regards the practice of using extrinsic evidence to show the inherent characteristics of a primary anticipatory reference. The MPEP explicitly states that "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such a gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Therefore, supplying the Gomori reference, which teaches the use of opposing buffer salts in particular ratios to obtain a specific pH (the descriptive matter which applicant contends is not inherently taught by the WO 98/36051 reference), is a proper recitation and does not raise new grounds of rejection after final rejection. This is because it was clearly presented on the record in the Final Office Action that using such buffers of opposing forms (e.g., potassium phosphate, the mono- and dibasic forms; see page 4 of Paper No. 10) to achieve a particular pH was well-known in the art, and applicants have persisted in arguing this point.

Continuation of 10. Other: It is noted that an IDS, submitted prior to the mailing of the Final Office Action but not present in the application prior to the mailing of said Action, was not considered on the record. That IDS is now considered on the record as if it was filed prior to Final, and a signed and initialed copy is attached to this Advisory Action. It is noted that the references have been lined through because the references had previously been considered on the record by the Examiner, as cited on a PTO-892 form which accompanied a non-final Office Action mailed June 17, 2002 as Paper No. 5. Thus the references are duplicates and need not be considered again.